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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,413	02/08/2001	Bernard J. Banks	PC10901A	9774

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EXAMINER

HENLEY III, RAYMOND J

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,413

Applicant(s)

BANKS ET AL.

Examiner

Raymond J. Henley III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

CLAIMS 1-11 ARE PRESENTED FOR EXAMINATION

Applicants' Amendment and Response filed January 21, 2004 has been received and entered into the application. No changes to the claims have been indicated by the Amendment.

Claim Rejection - 35 USC § 103

Claims 1-11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Harada et al. (EP 0 882 719)[Harada et al. '719] and Harada et al. (WO 98/57938)[Harada et al. '938], each of record, for the reasons of record as set forth in the Office action dated September 3, 2003.

Applicants' arguments at page 6 of their amendment have been carefully considered, but fail to persuade the Examiner of error in his determination of obviousness.

In particular, applicant has argued that the showing in the present specification of 2 specific compounds when tested in one particular animal, i.e., a dog, is sufficient to overcome the present rejection because the compounds tested in the specification and the animal are sufficiently similar to the genus of compounds claims and the genus of hosts, i.e., "companion animals.

The Examiner cannot agree that the present claims are patentable for the following reasons.

A) In claims 10-11, such phrase does not impart any physical or otherwise material limitation to the claimed composition that is not found in the prior art compositions. It is not material in a composition/formulation-type claim as to how the composition/formulation is to be employed, but rather what such a composition/formulation is in a physical sense.

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B) The claims are not commensurate in scope with data upon which applicants' rely for their assertion of patentability. The showing with only 2 specific compounds in 1 type of companion animal is insufficient to provide a reasonable basis to conclude that such results are representative of the results that could be achieved employing the genus of compounds presently claimed, especially because applicant's genus includes a compound shown not to meet the newly added claim recitation, i.e., the compound of Harada '938, Example 2, in all companion animals as presently claimed.

C) With specific reference to applicants' arguments above, the Examiner cites MPEP 2144.08(II)(B) which in-part reads:

"When considering whether proffered evidence is commensurate in scope with the claimed invention, Office personnel should not require the applicant to show unexpected results over the entire range of properties possessed by a chemical compound or composition. See, e.g., *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). Evidence that the compound or composition possesses superior and unexpected properties in one of a spectrum of common properties can be sufficient to rebut a prima facie case of obviousness. *Id.*

For example, a showing of unexpected results for a single member of a claimed subgenus, or a narrow portion of a claimed range would be sufficient to rebut a prima facie case of obviousness if a skilled artisan "could ascertain a trend in the exemplified data that would allow him to reasonably extend the probative value thereof." In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980) (*Evidence of the unobviousness of a broad range can be proven by a narrower range when one skilled in*

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the art could ascertain a trend that would allow him to reasonably extend the probative value thereof). But see, Grasselli, 713 F.2d at 743, 218 USPQ at 778 (evidence of superior properties for sodium containing composition insufficient to establish the non-obviousness of broad claims for a catalyst with “an alkali metal” where it was well known in the catalyst art that different alkali metals were not interchangeable and applicant had shown unexpected results only for sodium containing materials); In re Greenfield, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978) (evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (one test not sufficient where there was no adequate basis for concluding the other claimed compounds would behave the same way).” (emphasis added)

Here, the Examiner cannot agree that the 2 tested compounds are representative of the claimed genus because in applicants’ compound of claim 1, the variable group “Ar” represents a plethora of chemically different moieties and it is not seen that a trend could be ascertained by the skilled artisan from the testing of the two specific compounds in the present specification to allow him to reasonably extend the probative value thereof to all of compounds encompassed by the present claims. Also, as mentioned above in section “B)”, applicants’ genus includes a compound, i.e., the compound of Harada ‘938, Example 2, shown not to function in the manner claimed in all companion animals as presently claimed. Also, it remains that because the diverse nature of species of animals encompassed by the term “companion animal”, the showing of tests conducted in a dog cannot be reasonably extended to represent the entire genus of “companion animals”.

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Accordingly, for the above reasons, the claims are deemed to remain properly rejected and none are allowed.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 571-2720584. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Raynford J. Henley III
Primary Examiner
Art Unit 1614

Feb. 06, 2004